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GREGORY CHARLES FLICKINGER			ALPERT, JAMES M	
223 PHEASANT RUN SE			ART UNIT	
ROME, GA 30161			PAPER NUMBER	
			3693	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,051

Applicant(s)

FLICKINGER ET AL.

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following communication is in response to Applicant's amendment filed on 04/29/2006.

Status of Claims

Claims 1-24 are currently pending. Claims 1,3-18,21-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Suliman, US Patent Application Publication #20010053980 in view of Cheng et al, U.S. Patent #6457076. Claims 2,19-20,24 are rejected under 103(a) as being unpatentable over Suliman in view of Cheng and further in view of Rogers, U.S. Patent #5978774.

Response to Arguments

Applicant's arguments, affidavits, and exhibits, filed 04/29/2006 have been fully considered, but they are not persuasive as discussed below. Therefore, Claims 1-24 remain rejected as stated in the previous office action. The examiner will address the issues relating to the affidavits filed under 37 C.F.R. 1.131(b), and then the substantive comments regarding the rejections under 35 U.S.C. 103. In addition, the examiner presents two new grounds of rejection immediately below. Applicant's request for allowance is respectfully declined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11,19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. Specifically, in both independent claims, it is unclear how the asset data is acquired. That is to say, the claims recite "entering data specific to an asset" into the registration database, but there is no provision as to how this data is acquired. Is it acquired as part of a sale, or is it a pre-existing asset? Is it extracted or is it manually provided? The independent claims are unclear on these questions, and thus the claims are confusing and unclear. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-18 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Specifically, Claim 12 is directed to a machine-readable media having thereon a data file, whereby data is extracted from the file. The "Interim Guidelines for Examination of Patent Applications" shed light as to whether this claim is statutory. See pp. 50-52 of the Guidelines, as published on the USPTO website in PDF format. The guidelines say:

Computer data related products are classified into one of two groups, either

- 1) functional descriptive material, or
- 2) nonfunctional descriptive material

Functional descriptive material includes data structures and computer programs, which impart functionality when employed as a computer component. Certain functional descriptive material can be statutory, with an appropriate computer readable medium to

enable the functionality to be realized. In the instant claims, however, the data file residing on the media is nonfunctional descriptive material.

As set forth in the guidelines, when nonfunctional descriptive material is recorded on some computer-readable medium, it is non-statutory since no requisite functionality is present to satisfy the practical application requirement. Further, the “whereby” clause in the claim fails to bring the claim into the statutory realm since there is no language which further limits the claim to a particular structure which limits the scope of the claim to impart functionality to satisfy the practical application requirement. In other words, “whereby” or “wherein” clauses of intended use raise questions as to the limiting effect of the language. In this case, the machine-readable media does not have functionally and structurally interrelated elements on the media that perform extraction or automatic registration. Instead, the machine-readable media only positively contains the data. Thus claim, and those claims dependent therefrom, are non-statutory.

General Overview of 1.131 Requirements

37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

- (A) (actual) reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

Applicants are attempting to swear behind Suliman under (C).

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The MPEP has established some standards for examiner review as to the sufficiency of submissions under 1.131. Specifically, MPEP 715.07 recites:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

The same section continues:

... a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated.

and further,

Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In *re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33.

The standards above demonstrate that, with respect to both conception and diligence, it is not enough for an applicant to simply allege their existence. Rather, the exhibits should demonstrate clearly the facts of the claimed invention and corresponding limitations, while the affidavits should specifically refer to the exhibits, and explain how they demonstrate said facts. Given these requirements, it is obvious that Applicants' current submission falls short. Conception and diligence will now be discussed in greater detail.

Conception

The MPEP points out that conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc.

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In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In Mergenthaler, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must also be comprehended. Thus in order to establish conception, Applicants must be able to show that a clear idea of the complete claimed invention had been established, and not just a vague notion. While Exhibit A appears to show the “e-registrar” system as part of a larger registry system, the exhibit does not show the invention in detail, as currently claimed. That is to say, the exhibit does not demonstrate the limitations of the instant application. However, this is simply the examiner’s best guess, as the affidavits barely refer to the exhibits at all. In order to prove conception, Applicants are invited to submit as much additional material as possible to demonstrate the limitations of the claimed invention, along with detailed affidavits explaining the material, and how it relates to the claims as they currently stand.

Diligence

The MPEP points out that in determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958). However for purposes of advancing prosecution, the examiner would like to detail the requirement for establishing diligence.

Applicants correctly state the proper standard for determining the time frame for a showing of diligence for the instant application. The MPEP relates that under 37 CFR

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1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).

However, in showing diligence, Applicants should be aware that:

where conception occurs prior to the date of the reference, but reduction to practice is afterward, **it is not enough merely to allege that applicant or patent owner had been diligent.** Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence...

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP §2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field);

While the applicants may be required to show diligence for only a small period of time, it is clear that applicants will need to actually show diligence. Specifically, applicants may want to submit lab notes, sketches, brochures, etc that can demonstrate

that for the given time period required by the rules and MPEP, that on a daily basis, the Applicants were diligently engaged in developing the invention.

The Provisional Application of Suliman

While Applicants may read the underlying provisional reference to Suliman differently, the examiner is satisfied that the analysis provided in the non-final action of 01/30/2006 is correct. As such, the examiner maintains that those portions of the utility application presented as supported in that action will again be used in the current rejections.

Claim Rejections - 35 USC § 103

As mentioned above, Claims 1,3-18,21-23 stand rejected under 103(a) as being unpatentable over Suliman in view of Cheng while Claims 2,19-20,24 are rejected under 103(a) as being unpatentable over Suliman in view of Cheng and further in view of Rogers.

Applicants' primary argument under this section is a challenge to the examiners motivation to combine references under §103. Applicants argue that the examiner's motivation to combine references is based on hindsight to Applicants' disclosure. However, when considering obviousness §103, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Thus in essence,

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the job of the examiner is to place himself at a time when applicants' invention was made, and considering the known state of the art, ask himself would it have been obvious to an ordinary practitioner to combine those elements disclosed in the references.

For now, the examiner assumes that the data extraction process used with "cookie" technology is also known. Would it have been obvious to add these elements to the registration system of Suliman? What would be the general knowledge of one of ordinary skill in the art? Well as pointed out in (Para. 8) of Suliman, and as generally known to even members of the lay public, the continued growth of data processing and computing serves an overarching purpose, which is to make tedious tasks easier to complete, by becoming faster, quicker, and more automated. In this light, it is clear that combining these technologies would be obvious. This is still the case, even though the references may not specifically speak to the exact combinations of technology suggested by the examiner. This is because the motivation was common knowledge to an ordinary practitioner in the art at the time of the invention. While a farmer may not have known that an extraction method and registration system should have been combined, a computer scientist, networking professional, or IT professional certainly would have. Thus the examiner maintains that the motivation to combine references under 103(a) is not only not hindsight, but is also well known to be within the general knowledge of one of ordinary skill in the art.

Applicant next argues that "cookies" are not old and well known. The examiner directs Applicants to an "xreferplus.com" definition of cookies, dated 1995, 1998, and

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provided with this action, which explains that cookies can contain *“any arbitrary information the server chooses.”* Further the Microsoft Press Computer Dictionary, 3rd edition, points out that, “Cookies are used to identify users, to instruct the server to send a customized version of the requested Web page, to submit account information for the user, and for other administrative purposes. Applicants attempt to argue that somehow, the information that is contained in a data file under “e-registrar” system is different from that described in these definitions. The examiner does not find this argument persuasive in any way. An “e-register” data file containing name, address, purchase information, purchase date, etc can simply be a small file stored somewhere on one’s computer, and when accessing the central server of the “e-register” system, in a form similar to the extraction of a cookie file, the server will extract the data from the data file. The examiner is satisfied that this limitation is sufficiently described by the above-cited references, which adequately read on Applicants’ claim limitation.

Applicants argue next that the motivation to combine Suliman with cookie technology (making a system faster) is too general. To the contrary, an ordinary practitioner at the time Applicants’ invention was made, might be thinking along these lines: “Here is a registration system that has a central database which stores registration information from remote computers (and other features not necessarily described here), and here is ‘cookie’ technology that allows for pulling information off a remote computer without the need of any action of the remote user. You know if I combine these two ideas, it would really speed things up in this registration system.” To

an ordinary practitioner, how could he/she not reach this conclusion? Thus, the examiner maintains his rejections under 103, and:

With regard to Claims 1,12,18, Suliman teaches a method comprising:
providing an electronic registration database; (Para. 11 lines 1-3)

With regard to the following limitation:
providing an electronic data file comprising data specific to an entity that purchases or owns assets,

Suliman teaches this limitation at (Para. 37 lines 5-10). Suliman does not expressly teach the method wherein:

the electronic data file is in the possession of the entity;

However, Cheng teaches such a file in an analogous application at (Col. 7, lines 12-39; Col. 8, lines 44-54; Col 13, lines 29-45; Col. 24, lines 63 – Col. 25, line 4). These passages refer to customer information that is stored on a client computer for use in updating software files. It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Suliman, relating to a consumer/product registration system, with the teachings of Cheng, relating to maintaining a small data file contain personal information. The motivation for such a combination is found in Suliman at (Para. 8) which indicates that these registration systems are designed to simplify and automate the collection of consumer and product information. Certainly, maintaining a small file as described in Cheng will further automate the system. As well, automation and simplification are well within the general knowledge of one possessing ordinary skill in the art. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Lee, 277 F.3d 1338, 1342-44, 61

USPQ2d 1430, 1433-34 (Fed. Cir. 2002); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Continuing, Suliman does not expressly teach the next limitation:

extracting the data specific to an entity from the electronic data file and entering it into the registration database;

However, as pointed out above, cookies are old and well known, and that technology reads on this limitation exactly. Further, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Suliman, relating to a registration database and corresponding customer information data file, with an extraction technology. The motivation for such a combination is to increase the speed with which the system operates. The method of extraction of the file would obviously save time to a user who would otherwise be required to type in information, over and over. This decrease in processing time is an objective that is within the knowledge that is generally available to one of ordinary skill in the art. As mentioned above, Suliman also expressly remarks that simplification and automation are goals in improving systems.

With regard to Claim 2, Applicants argue that the cited reference is not analogous art. In response, please note that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Rogers reference is in the same field as applicants' invention, namely registering products. Rogers is not cited however,

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to show entry of purchaser data, but rather to show entry of registration information at the time of a purchase. This is all that is required of the limitation in Claim 2. As such the examiner maintains his rejection that Rogers reference teaches:

registration is performed during the purchase of the asset. (Para. 12, lines 1-3).

Further, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of a Suliman/Cheng combination, relating to a registration database and corresponding customer information data storage file, with the teachings of Rogers, relating to point-of-sale product registration. The motivation for such a combination is simply to increase confidence in the system by eliminating any possible errors that could occur from registering at a later time, for example forgetfulness, memory deletion, etc. Contrary to applicants' assertions, this is not hindsight, but rather knowledge generally known to one of ordinary skill in the art.

Finally, the examiner does not agree with Applicants' assertion that the Suliman provisional does not teach this limitation. It is not expressly unambiguous how (Page 3, 2nd full paragraph) implements the registration at the time of purchase, but it is clear that "at the time of purchase" is a critical feature. This paragraph can be interpreted as reading on this claim.

With regard to Claims 3, 13 stating:

the method of claim 1, wherein the electric file is provided on a media that is loaded onto a purchasing entity's or owner entity's computer.

The examiner is interpreting the term "loaded onto" to mean storing a data file onto a hard drive of PC. This claim is inherent to any type of file maintained on

computer memory, and would include the type disclosed by a Suliman/Cheng combination.

With regard to Claim 4, stating:

the method of claim 3, wherein the data specific to an entity is extracted by an application on a second computer through a computer network, such as the Internet.

This claim is rejected under a similar analysis as the limitation in Claim 1, describing extraction.

With regard to Claims 5,14 stating:

the method of claim 1, wherein the electronic file is installed on a media accessible to a third party's computer.

This claim is inherent to any system executing a remote extraction. That is, in any situation where data would be remotely extracted, it is inherent that the remote computer would have to obtain access to the computer from which it expects to extract data. As such this claim is rejected under a similar analysis as Claim 4.

With regard to Claims 6,15 stating:

the method of claim 5, wherein the third party is a credit card company.

The examiner has provided documentary evidence, specifically, the Herz reference, U.S. Patent #6571279, in a previous action as to why this limitation is well known, and obvious. The examiner suggests that Applicants' review this reference for to understand why card companies possess an interest, if not compelling interest, in product registration. The motivation to combine is found in Herz, which describes monitoring spending patterns of customers as important to card companies. In addition, monitoring warranty issues as they relate to card backed reimbursement plans would be

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motivation to maintain a registration system. The examiner, as one of ordinary skill in the art, observes that it only makes common sense to be interested in having registration of products that a card issuer may later be paying to replace.

With regard to Claims 7,16 Suliman (as supported by the provisional application) does not expressly teach the method wherein:

the data file is an electronic file installed on a smart credit card.

However the examiner takes Official Notice that the use of smart cards for storing personal information of the type disclosed by applicant is very old and well known in the art. Smart-card technology is well established, and to modify the point-of-sale technique described in Claim 2 to utilize smart cards in the sales and registration process is obvious. The motivation for modifying the system to include smart card technology is simply is to diminish processing speeds in that retrieving stored information is faster than giving information at the point of sale.

Applicants attempt to traverse the use of official notice in this instance, but do not state their objection in the form of a traversal explaining why smart card are not well known. As mentioned in previous rejections, MPEP § 2144.03(C) implores applicants to adequately present their objections so time is not wasted citing references for well-known limitations. If Applicants truly believe that smart card technology did not exist as of the filing of the instant application, then they should so state.

With regard to Claims 8-9, 17 stating:

the method of claim 1, wherein the data file includes data for insuring an asset, and wherein an insurer has access to the electronic registration database and automatically insures an asset when it is registered.

Applicant is reminded that claims may be given the broadest reasonable interpretation. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The examiner asserts that warranty protection is a form of insurance. That is to say, the price of goods takes into consideration the necessity of manufacturers to occasionally replace an item that breaks, is defective, or even subject to user neglect that is later claimed to be a defect. To that extent, much of the entire Suliman reference is directed toward automatically insuring an asset.

With regard to Claim 10, Suliman teaches a method wherein:

the registration database provides a composite record of assets registered by specific entities and allows for the reporting and manipulation of the same. (Para. 52)

With regard to Claim 11, Suliman teaches a method wherein:

entities maintain control over personal, and or entity registration data. (Para. 66)

With regard to Claim 19, Suliman does not expressly teach the method wherein:

asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data.

However, Rogers teaches this limitation at (Col. 2, lines 28-45), describing point-of-sale registration. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of a Suliman/Cheng combination, relating to a registration database and corresponding customer information storage data file, with the teachings of Rogers, relating to point-of-sale product registration. The motivation for such a combination is simply to increase confidence in the system by eliminating any possible system errors that could occur from registering

at a later time, for example, forgetfulness or memory deletion, etc. This motivation is knowledge generally available to one of ordinary skill in the art.

With regard to Claim 20, Suliman does not expressly teach the method wherein:

said asset data is obtained at the time of purchase of the asset.

However this claim is rejected under a similar analysis as in Claims 2,19.

With regard to Claim 21, Suliman teaches the method wherein:

said data specific to an entity is extracted at the time of purchase of the asset.
(Para. 12, lines 1-3)

This portion of the reference is supported in the provisional application at (Page 3, 2nd full paragraph).

With regard to Claim 22, Suliman teaches the method wherein:

data file is located on the entity's computer and at least a subset of said data specific to the entity is entered into the electronic data file by the entity.

In terms of the data file itself, this would be inherent to the system as described in the analysis of the 2nd limitation of Claim 1, and is likewise rejected in view of a Suliman/Cheng combination. In reference to entry of data by the entity, Suliman teaches this method at (Paras. 37,51)

With regard to Claim 23, Suliman teaches the method wherein:

the entity is able to directly modify the entity specific data. (Paras. 37,51)

With regard to Claim 24, this claim is essentially the same as claim 1 with the exception that there is a prohibition of manual entry by the entity regarding asset data. However, as discussed in relation to Claims 2 and 19-20, Rogers teaches this missing

limitation. This claim is thus rejected over Suliman in view of Cheng in further view of Rogers under the same rational as discussed in Claims 2 and 20.

Applicants assert that the motivation to combine references is not within the general knowledge of one of ordinary skill in the art. The examiner notes that even with use of applicants' proposed invention, unless a registration is performed at the time of sale, one could easily forget to log onto the appropriate web site to complete the registration process. Contrary to applicants' assertion, this simple motivation is obvious to anyone who is a practitioner in the electronic commerce arts, including the examiner, Applicants, etc.

Conclusion

THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel, can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private


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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197. Respectfully
offered,

James M. Alpert
July 14, 2006



ELLA COLBERT
PRIMARY EXAMINER